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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/341,287 08/19/99 WOODS

J LC-302/PCT/U

Loctite Corporation
Legal Department
1001 Trout Brook Crossing
Rocky Hill CT 06067

IM22/0501

EXAMINER

WILSON, D

ART UNIT	PAPER NUMBER
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1713

DATE MAILED:

05/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

09/341,287

Applicant(s)

WOODS ET AL.

Examiner

D. R. Wilson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 April 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check only a) or b)]


- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attachment.

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☐ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1-5, 8, 9 and 12-15.
- Claim(s) withdrawn from consideration: 6, 7, 10, 11 and 16-20.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
11. ☒ Other: PTO-892 Attached.


D. R. Wilson
Primary Examiner
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ADDITIONAL COMMENTS

Response to Proposed Amendment After Final

1. Applicant's proposed amendment filed 4/25/01, after final rejection, has been fully considered with the following results.
2. The proposed amendment will not be entered because it adds a new claim with limitations which have not been considered. Specifically the molecular weight limitation of newly presented Claim 22 has not been considered.
3. If entered the amendment would have overcome the objection to new matter, the corresponding rejection under 35 U.S.C. § 112, first paragraph, and the rejections under 35 U.S.C. § 112, second paragraph, and the objection and rejections would have been withdrawn.
4. Applicants argument traversing the rejection of Claims 1-5, 8-9 and 12-15 under 35 U.S.C. 103(a) as being unpatentable over Okamoto in view of Examiner's Notice, in further view of Wu or Yoshino, is not deemed to be persuasive for reasons which follow.
5. Applicant traverses the rejection challenging the Examiner's Notice *that "--- It is well known that reactions utilizing ethylene oxide have the disadvantage of ethylene oxide being a gaseous and highly toxic material."* First, it is pointed out that failure of the applicant to seasonably challenge such assertions establishes them as admitted prior art. See *In re Gunther*, 1942 C.D. 332; 538 O.G. 744; *In re Chevenard*, 1944 C.D. 141; 500 O.G. 196. Challenging the Examiner's Notice at this point in the prosecution is not seen to be timely. Further,

--- things believed to be known to those skilled in the art are often asserted by the examiner to be well known, or matters of common knowledge. If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. *In re Malcolm*, 1942 C.D. 589; 543 O.G. 440.

A challenge to the taking of judicial notice must also contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice. *In re Boon*, 58 CCPA 1035, 169 USPQ 231 (1971). However, even though applicant is not seen to have timely and properly challenged the Examiner's Notice, applicant is referred to the Merck Index, p 3759, which points out that ethylene oxide is both explosive and reasonably anticipated to be a carcinogen. This is

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information which would have been well known to those of ordinary skill in the art, and clearly provided a motivation not to use ethylene oxide. The argument that "[t]he chemical industry is familiar with how to handle toxic chemicals on a routine basis", does not negate that there are disadvantages to using an explosive and highly toxic material when alternatives become known and available. The Examiner does not disagree that ethylene oxide can be safely handled. However, there is clearly added cost to provide the necessary safety and protection which is not necessary with less dangerous materials. Applicant also acknowledges this on page 13 of the response, i.e., "--- and require neither special handling conditions nor equipment." It is also noted as pointed out in the first Office Action that:

- (i) "Applicant also appears to acknowledge this fact [that reactions utilizing ethylene oxide have the disadvantage of ethylene oxide being a gaseous and highly toxic material] in the present specification (page 2)",
- (ii) "Yoshino also teaches that ethylene carbonate has been accepted as an alternative hydroxyethylating agent to the hazardous ethylene oxide (p 1266, 1st paragraph)", and
- (iii) "Wu also teaches the advantageous use of ethylene carbonate to hydroxyethylate a number of polyacids including both aliphatic and aromatic acids (col. 1, lines 1-54)."

6. The argument that Okamoto does not recognize that ethylene oxide may have a disadvantage, or that Okamoto itself does not provide the motivation to combine the teachings of Wu or Yoshino, is not deemed to be persuasive because Okamoto was not relied upon for the motivation.

7. Applicant argues that there is a further deficiency in Okamoto in view of the Examiner's Notice in that one would have to be further motivated to look for a replacement for the "tertiary amine catalyst" which is a necessary ingredient in the process of Okamoto. This is not deemed to be persuasive because one of ordinary skill in the art would know to use the catalysts taught by the secondary references for the reaction of carboxylic acid groups with ethylene carbonate, not the catalysts taught by Okamoto for the reaction of carboxylic acid groups with ethylene oxide.

8. Applicant further argues that Wu and Yoshino are non-analogous art because it is concerned with the hydroxyalkylation of monomeric compounds as opposed to the polymeric compound of Okamoto. However, as has been previously pointed out,

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"The determination that a reference is from a non-analogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058."

"In the instant it is believed that art involving the carboxylic acid hydroxyalkylation of polymers is within the field of endeavor of applicant, and even if not, the added references are clearly reasonably pertinent to the particular problem with which the inventor was involved."

Any argument that the reactions of monomeric carboxylic acids would not be expected to apply to polymeric carboxylic acids due to the unpredictable nature of the chemical arts is also not deemed to be persuasive. The reactions of polymeric compounds are not considered to be based on a chemistry, which is absent in the chemistry of small molecules.

It is established patent law that "obviousness does not require absolute predictability". *In re Miegel* 159 USPQ 716. *Prima facie* obviousness requires only that a reasonable expectation of success exist; absolute predictability is not required. *In re O'Farrell* 7 USPQ 2d 1673.

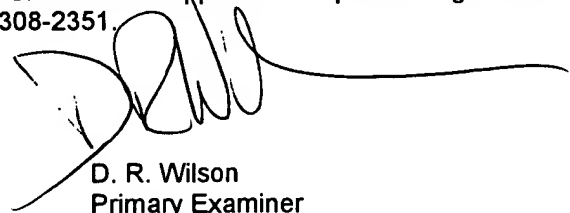
9. The argument that controlling the molecular weight of the hydroxyalkylated final product is critical is not deemed to be persuasive because this is not a limitation of the claims which have been examined.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R. Wilson
Primary Examiner
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